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July 15, 2002

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Commissioner of Patents
Washington, D.C. 20231

Re: U.S. Patent Application No. 09/552,087
Filed: April 21, 2000
Title: Nucleic Acid Molecules and Other Molecules Associated with Plants
Inventors: Joseph R. BYRUM *et al.*
A&P Ref. No.: 16517.132

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office:

1. Response to Office Action dated June 13, 2002; and
2. Return postcard.

Please stamp the attached postcard with the filing date of these documents and return it to our courier.

Applicants do not believe that any fees are due in conjunction with this filing. If, however, any fees are required, including any extension of time fees to prevent abandonment of this application, then such extension is hereby petitioned. The Commissioner is hereby authorized to charge any fee deficiency and/or credit any overpayment to our Deposit Account No. 50-1824, referencing matter number 16517.132.

Respectfully submitted,

David R. Marsh (Reg. No. 41,408)

June E. Cohan (Reg. No. 43,741)

Holly Logue Prutz (Reg. No. 47,755)

Attachments

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re application of:

Joseph R. BYRUM *et al.*

Appln. No.: 09/552,087

Filed: April 21, 2000

For: Nucleic Acid Molecules and Other
Molecules Associated with Plants

Art Unit: 1634

Examiner: J. C. Einsmann

Atty. Docket: 16517.132

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Response to Office Action dated June 13, 2002

Commissioner for Patents
Washington, D.C. 20231

Sir:

In the Office Action mailed June 13, 2002 (paper number 11), the Examiner states that Applicants' prior response filed on February 19, 2002, is "not fully responsive ...because the response does not properly address the provisional 102(e) and obviousness-type double patenting rejections." According to the Examiner, "[a] request to hold these in abeyance [sic] is not a proper response." Applicants respectfully disagree and direct the Examiner's attention to MPEP § 804 which permits Applicants to eliminate all other outstanding rejections in the application before addressing a provisional double-patenting rejection is made between two (or more) pending applications.¹ (MPEP § 804 at 800-19). Furthermore, this section states that "[t]he

¹ MPEP § 804 reads in relevant part:

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications. If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.

If the "provisional" double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application

merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue." *Id.* (emphasis added). Thus, although Applicants may select to address the provisional obviousness-type double patenting rejection and the provisional 102(e) rejection, Applicants are under no obligation to do so unless and until allowable subject matter is identified in at least one of the pending applications.

The Examiner alleges that "[a] proper response will substantively address the grounds of the rejection." Applicants respectfully disagree with the Examiner's assertion, and maintain that their request to hold the provisional rejection in abeyance until otherwise allowable subject matter is identified is a fully responsive reply to a *provisional* rejection under established policy as set forth in the MPEP. Applicants also maintain that submission of a "substantive" reply to a provisional rejection, *i.e.*, before the identification of otherwise allowable subject matter, would not facilitate prosecution as it would not necessarily fully address the merits of an actual *rejection* made once otherwise allowable subject matter is identified.

When otherwise allowable subject matter is identified in one of applications 09/552,087, 09/421,106, and 09/521,640, and the provisional rejection is converted into a rejection, Applicants will take appropriate action at that time. Until that time, Applicants submit that they have fully responded to the provisional rejection.

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn.

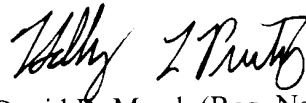
with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a "provisional" double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.

MPEP § 804 at 800-19.

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided. Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Applicants do not believe that any fees are required in conjunction with this response. However, if any additional fees are required for any reason relating to this document, the Commissioner is authorized to deduct the fees from Arnold & Porter Deposit Account No. 50-1824 referencing matter number 16517.132.

Respectfully submitted,



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June E. Cohan (Reg. No. 43,741)
Holly Logue Prutz (Reg. No. 47,755)

Date: July 15, 2002

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